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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,365	08/31/2000	Viktors Berstis	AUS9-2000-0295-US1	4454
35525	7590	06/13/2006	EXAMINER	
IBM CORP (YA)			STORK, KYLE R	
C/O YEE & ASSOCIATES PC				
P.O. BOX 802333			ART UNIT	
DALLAS, TX 75380			PAPER NUMBER	
			2178	

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/652,365

Applicant(s)

BERSTIS ET AL

Examiner

Kyle R. Stork

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This non-final office action is in response to the Appeal Brief filed 28 April 2006.
2. Claims 1-36 are pending. Claims 1, 9, 16, 20, 28, 35, and 36 are independent claims. The rejection of claims 1-36 have been withdrawn based upon the applicant's arguments submitted in the Appeal Brief.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 6-8, 20, 25-27, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gipson (US 5778402, filed 7 July 1998) and further in view of Mansfield (Mastering Word 97: Fourth Edition, 1997, pp. 93-94).

As per independent claim 1, Gipson discloses a method in a data processing system for modifying original content of a document, the method comprising:

- Receiving a request for modified content (column 4, lines 35-41: Here, a request is an user input event)
- In response to each receipt of the request, modifying the original content, using a set of rules to modify selected content in the document without degrading readability of the document, to form a modified document, wherein unmodified

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content in the modified document retaining its original physical and spatial characteristics after a portion of the content is modified (column 4, lines 42-50: Here, the a set of rules defines an auto-format content. A user input event that meets a set of rules, activates an auto-format, thus generating modified content and similarly a modified document; column 7, lines 1-12: Here, an example of an auto-format is disclosed. Further, only the “\*” is modified. The following word, and its physical and spatial characteristics remain unmodified)

- Displaying the modified document having the original physical and spatial characteristics for the unmodified content (column 7, lines 1-12)

Although Gipson fails to specifically disclose rules for making text invisible, Gipson suggests that a document may include invisible text (column 11, lines 50-58: Here, the concept of hidden or invisible text within a document is disclosed). However, Gipson fails to specifically disclose invisible text. However, Mansfield discloses invisible text (pages 93-94: Here, text, including paragraph marks, dots denoting spaces, and arrows denoting tab characters, are hidden from a user by clicking on the Show/Hide button on the toolbar). Further, Mansfield teaches rules for determining which text should be invisible (pages 93-94: Here, text characters that are not paragraph marks, dots denoting spaces, arrows denoting tab characters, dashed lines for pages, section, and column breaks, and text and graphic boundaries are hidden). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Gipson's use of a rules engine with Mansfield's use of invisible text, since it would have allowed for a document to be auto-formatted based upon user entries.

Gipson fails to specifically disclose wherein the selected content in the document being made invisible increases a speed at which a user can read the modified document relative to a speed at which the user can read the document without modifications. However, one of ordinary skill in the art at the time of the applicant's invention would have recognized that, all else being equal, the relative speed at which a user can read a document is at least partially related to the number of words within a document. Therefore, by reducing the number of words in a document the relative reading speed of the document by the user would subsequently increase.

As per dependent claim 6, Gipson and Mansfield disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Gipson further discloses a set of rules (column 4, lines 42-50) and the ability for text to be invisible (column 11, lines 50-58). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Gipson's use of a rules engine with Gipson's use of invisible text, since it would have allowed for a document to be auto-formatted based upon user entries (abstract).

As per dependent claim 7, Gipson and Mansfield disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Gipson further discloses the set of rules including rules to retain words (Figure 5: Here, if a word does not trigger an action, then the word is retained).

As per dependent claim 8, Gipson and Mansfield disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Gipson further

discloses the set of rules includes rules to replace words (Figure 5; column 7, lines 1-12).

As per independent claims 20 and 35, the applicant discloses the limitations similar to those in claim 1. Claims 20 and 35 are similarly rejected.

As per dependent claim 25, the applicant discloses the limitations similar to those in claim 6. Claim 25 is similarly rejected.

As per dependent claim 26, the applicant discloses the limitations similar to those in claim 7. Claim 26 is similarly rejected.

As per dependent claim 27, the applicant discloses the limitations similar to those in claim 8. Claim 27 is similarly rejected.

5. Claims 2-4, 9-11, 13-23, 28-30, 32-34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gipson and Mansfield and further in view Belanger et al. (US 2001/0020244, provisional filed 15 November 1996, hereafter Belanger).

As per dependent claim 2, Gipson and Mansfield discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Gipson fails to specifically disclose the method wherein the document is a web page. However, Belanger discloses a web page (paragraph 0007: Here, a portion of a web site is a web page).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Gipson's method with Belanger's method, since

it would have allowed a user to remotely author and modify documents (Belanger: paragraphs 0007-0008).

As per dependent claim 3, Gipson and Mansfield discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Gipson fails to specifically disclose the method wherein the document is a hypertext markup language document. Belanger discloses the method wherein the document is a hypertext markup language document (Figure 6; paragraph 0018).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Gipson's method with Belanger's method, since it would have allowed a user to remotely author and modify documents (Belanger: paragraphs 0007-0008).

As per dependent claim 4, Gipson and Mansfield discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Gipson fails to specifically disclose the method wherein the receiving step and the modifying step are performed in a server data processing system. Belanger discloses the method wherein the receiving step and the modifying step are performed in a server data processing system (paragraph 0007: Here, the server performs the modifications).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Gipson's method with Belanger's method, since it would have allowed a user to remotely author and modify documents (Belanger: paragraphs 0007-0008).

As per independent claim 9, the applicant discloses the limitations similar to those of claims 1 and 2. Claim 9 is similarly rejected.

As per dependent claim 10, the applicant discloses the limitations similar to those of claim 3. Claim 10 is similarly rejected.

As per dependent claim 11, the applicant discloses the limitations similar to those of claim 4. Claim 11 is similarly rejected.

As per dependent claim 13, the applicant discloses the limitations similar to those of claim 6. Claim 13 is similarly rejected.

As per dependent claim 14, the applicant discloses the limitations similar to those of claim 7. Claim 14 is similarly rejected.

As per dependent claim 15, the applicant discloses the limitations similar to those of claim 8. Claim 15 is similarly rejected.

As per independent claim 16, the applicant discloses the limitations similar to those of claims 1 and 2. Gipson further discloses the use of a computer including a bus system, communication adapter, and memory (column 3, lines 1-41). Claim 16 is similarly rejected under Gipson and Belanger.

As per dependent claim 16-19, Gipson, Mansfield, and Belanger disclose the limitations similar to those in claim 16. Gipson discloses a computer system having an arrangement obvious to one of ordinary skill in the art at the time of the applicant's invention, including primary and secondary busses and one or more processors (column 3, lines 1-41)



As per dependent claim 21, the applicant discloses the limitations similar to those of claim 2. Claim 21 is similarly rejected.

As per dependent claim 22, the applicant discloses the limitations similar to those of claim 3. Claim 22 is similarly rejected.

As per dependent claim 23, the applicant discloses the limitations similar to those of claim 4. Claim 23 is similarly rejected.

As per independent claim 28, the applicant discloses the limitations similar to those of claims 1 and 2. Claim 28 is similarly rejected.

As per dependent claim 29, the applicant discloses the limitations similar to those of claim 3. Claim 29 is similarly rejected.

As per dependent claim 30, the applicant discloses the limitations similar to those of claim 4. Claim 30 is similarly rejected.

As per dependent claim 32, the applicant discloses the limitations similar to those of claim 6. Claim 32 is similarly rejected.

As per dependent claim 33, the applicant discloses the limitations similar to those of claim 7. Claim 33 is similarly rejected.

As per dependent claim 34, the applicant discloses the limitations similar to those of claim 8. Claim 34 is similarly rejected.

As per independent claim 36, the applicant discloses the limitations similar to those of claims 1 and 2. Claim 36 is similarly rejected.

6. Claims 5, 12, 24, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gipson and Mansfield, and further in view of Lo et al. (US 6212534, filed 13 May 1999, hereafter Lo).

As per dependent claim 5, Gipson and Mansfield disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Gipson fails to specifically disclose the method wherein the receiving step and modifying step are performed in a client data processing system. However, Lo suggests the method wherein the receiving step and modifying step are performed in a client data processing system (column 9, lines 5-47). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Gipson's method with Lo, since it would have allowed a user to remotely author and modify documents (Lo: column 9, lines 5-47).

As per dependent claim 12, the applicant discloses the limitations similar to those in claim 5. Claim 12 is similarly rejected.

As per dependent claim 24, the applicant discloses the limitations similar to those in claim 5. Claim 24 is similarly rejected.

As per dependent claim 31, the applicant discloses the limitations similar to those in claim 5. Claim 31 is similarly rejected.

### ***Response to Arguments***

7. Applicant's arguments, see Appeal Brief, filed 28 April 2006, with respect to the rejection(s) of claim(s) 1-36 have been fully considered and are persuasive. Therefore,

the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

The applicant argues that Gipson fails to teach invisible text (page 20). Although the examiner respectfully disagrees, the Mansfield reference has been added to teach invisible text (pages 93-94). Here, text characters that are not paragraph marks, dots denoting spaces, arrows denoting tab characters, dashed lines for pages, section, and column breaks, and text and graphic boundaries are hidden. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Gipson's use of a rules engine with Mansfield's use of invisible text, since it would have allowed for a document to be auto-formatted based upon user entries.

The applicant argues that the combination of Gipson and Belanger fails to teach modification performed in a client data processing system (page 30). The examiner agrees with this argument. However, Lo teaches this limitation (column 9, lines 5-47). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Gipson's method with Lo, since it would have allowed a user to remotely author and modify documents (Lo: column 9, lines 5-47).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyle R Stork  
Patent Examiner  
Art Unit 2178

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**CESAR PAULA**  
**PRIMARY EXAMINER**